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United States Court of Appeals
For The Federal Circuit

IN RE JOHN A. WHEATLEY and WALTER J. SCHRENK

Appeal from the United States Patent and Trademark Office,
Board of Patent Appeals and Interferences in
Appeal No. 2005-2515, Patent Application No. 09/911,532

REPLY BRIEF OF APPELLANTS

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October 6, 2006

CERTIFICATE OF INTEREST

Counsel for the Appellants certifies the following:

- 1. The full name of every party represented by me is:**

JOHN A. WHEATLEY, WALTER J. SCHRENK

- 2. The name of the real party in interest represented by me is:**

3M INNOVATIVE PROPERTIES COMPANY

- 3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party represented by me are:**

3M Innovative Properties Company is a wholly owned subsidiary of 3M Company. There is no parent corporation of 3M Company. There is no publicly held company that owns 10 percent or more of the stock of 3M Company.

- 4. The names of all law firms and the principals or associates that appeared for the party now represented by me in the United States Patent and Trademark Office or are expected to appear in this Court are:**

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TABLE OF CONTENTS

	<u>PAGE</u>
Certificate of Interest.....	i
Table of Authorities	iii
Introduction	1
Argument.....	1
I. The Director's Defense of the Board's Finding of "Express Suggestions" to Combine the Teachings of Rogers and the Utsumi References Seeks a New, Expanded Legal Definition of an "Express Suggestion" to Combine That Is Not Supported By This Court's Precedent.	1
II. The Director's Attempts to Bolster the Board's Finding of an "Express Suggestion" To Replace PET With PEN Fail.....	6
A. The Director's "All Optical Films Are Alike" and "PEN Is a Better Polarizer Than PET" Arguments Make No Sense In the Context of the Cited Rogers-Utsumi Combination.....	6
B. The Director First Concedes That the Problems Facing Drs. Wheatley and Schrenk Define What Art They Would Have Been Motivated To Combine, and Then Promptly Ignores Those Problems.....	8
III. The Director's Waiver Argument Cannot Excuse the Board's Failure To Cite Any Evidence Supporting a Finding That There Would Have Been a Reasonable Expectation of Success In Combining Rogers With Either Utsumi Reference	11
Conclusion and Statement of Relief Sought	15
Proof of Service	

TABLE OF AUTHORITIES

CASES	<u>PAGE</u>
<i>Alza Corp. V. Mylan Labs., Inc.</i> , No. 06-1019, ___ F.3d ___, 2006 WL 2556356 (Fed. Cir. Sep. 6, 2006).....	3
<i>Amgen, Inc. V. Chugai Pharm. Co.</i> , 927 F.2d 1200 (Fed. Cir. 1991)	13
<i>Dystar Textilfarben GmbH & Co. Deutschland KG V. C.H. Patrick Co.</i> , No. 06-1088, ___ F.3d ___, 2006 WL 2806466 (Fed. Cir. Oct. 3, 2006).....	3
<i>In Re Fine</i> , 837 F.2d 1071 (Fed. Cir. 1988)	3, 12
<i>In Re Hyatt</i> , 211 F.3d 1367 (Fed. Cir. 2000).....	14
<i>In Re Kahn</i> , 441 F.3d 977 (Fed. Cir. 2006).....	3
<i>In Re Kotzab</i> , 217 F.3d 1365 (Fed. Cir. 2000)	2, 10
<i>Medichem, S.A. V. Rolabo, S.L.</i> , 437 F.3d 1157 (Fed. Cir. 2006)	11, 13
<i>In Re O'Farrell</i> , 853 F.2d 894 (Fed. Cir. 1988).....	11, 12, 13, 14
<i>In Re Rinehart</i> , 531 F.2d 1048 (CCPA 1976)	3
<i>In Re Roemer</i> , 258 F.3d 1303 (Fed. Cir. 2001).....	13
<i>Velandar V. Garner</i> , 348 F.3d 1359 (Fed. Cir. 2003)	13
<i>In Re Watts</i> , 354 F.3d 1362 (Fed. Cir. 2004)	14
<i>In Re Zurko</i> , 258 F.3d 1379 (Fed. Cir. 2001).....	10

STATUTES

PAGE

35 U.S.C. § 103(A) 12

INTRODUCTION

The Director's efforts to defend the Board's *prima facie* conclusion that the claims at issue here would have been obvious fall short for a number of reasons. ***First***, the Director advances an expansive new legal theory of what constitutes an "express suggestion" to combine prior art references that finds no support in this Court's precedent. ***Second***, the Director's arguments supporting the Board's finding of so-called "express suggestions" to combine the cited references fail because they, like those made by the Board, continue to ignore the fundamental differences between the cited references, as well as the problems facing the inventors. ***Finally***, the Board cited no evidence at all establishing that one skilled in the art would have had a reasonable expectation of success in combining the cited references, and this argument was not waived below. For these reasons, the Board's decision that claims 30 and 32-35 of the Application would have been *prima facie* obvious lacks support by substantial evidence and should be reversed.

ARGUMENT

I. The Director's Defense of the Board's Finding of "Express Suggestions" to Combine the Teachings of Rogers and the Utsumi References Seeks a New, Expanded Legal Definition of an "Express Suggestion" To Combine That Is Not Supported By This Court's Precedent.

In their opening brief, Drs. Wheatley and Schrenk (collectively, "Wheatley") explained at length that the fundamental differences between the teachings of

Rogers and both Utsumi references demonstrate that the Board's finding of "express suggestions" to combine them is not supported by substantial evidence. In sum, the Utsumi references discuss certain specific benefits of the use of single layer PEN films in two specific applications – polarizing plates containing dichroic dyestuff and liquid crystal panel substrates –without any indication that PEN could be used as a substitute for PET in any other application (much less a multilayer polarizer such as Rogers, with its careful selection of alternating layers of diverse polymeric materials with differing indices of refraction).

In response, the Director simply repeats the Board's reasoning that the Utsumi references' "express suggestions" to make the Rogers-Utsumi combination are found in the Utsumi references' general "preference" or "advantage" in using PEN over PET. (Dir. Br., pp. 1, 6, 9, 14, 16-17)¹ But tellingly, the Director cites no authority for the novel and remarkable proposition that a reference that suggests replacing one material for another for a specific use thereby "expressly suggests" that same substitution of materials in all other uses, even uses that are fundamentally different.

¹ It is ironic that the Director criticizes Wheatley for "attacking the references individually" (Dir. Br., pp. 19-21), when it is the Director's argument that seeks to extract a general preference for the use of PEN in favor of PET from the Utsumi references, while ignoring the overall teachings of the Utsumi references – in particular, the specific applications for which the Utsumi references teach the use of PEN. See *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000) (statements in prior art references "must be considered in the context of the teaching of the entire reference").

The Director fails to cite such authority because this Court has never applied the “express suggestion” test so loosely. To the contrary, longstanding precedent from this Court and its predecessor holds that whether an express suggestion exists to combine references must be determined in view of the problem facing the inventor. *See, e.g., Alza Corp. v. Mylan Labs., Inc.*, No. 06-1019, ___ F.3d ___, 2006 WL 2556356, *3 (Fed. Cir. Sep. 6, 2006) (motivation to combine references is determined by considering “the general problem facing the inventor”); *In re Kahn*, 441 F.3d 977, 989 (Fed. Cir. 2006) (same); *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988) (prior art should not be combined where purposes of references “are entirely unrelated”); *In re Rinehart*, 531 F.2d 1048, 1053-54 (CCPA 1976) (prior art’s teaching of ways to increase reaction rate does not provide motivation to combine when inventor’s problem was not the need for increased reaction rates).²

No case holds that a reference expressly suggests exchanging one material for another in *any use* just because it suggests exchanging the material for *one specific use*. To hold to the contrary would divorce the question of what constitutes an express suggestion to combine references from the context of the

² *See also DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, No. 06-1088, ___ F.3d ___, 2006 WL 2806466, *13 (Fed. Cir. Oct. 3, 2006) (motivation to combine is tied to inventor’s “problem-solving abilities”).

references themselves, and from the nature of the problem to be solved, thus depriving the express suggestion test of any real meaning.

The Director's proposed expansion of what constitutes an express suggestion to combine references is particularly unwarranted in this case, where the cited combination is the substitution of one material for another – namely, replacing Rogers' PET layer with PEN. In fact, Rogers discusses several polymers in addition to PET useful in forming the layers of his multilayer film:

Certain materials readily lend themselves to the coextrusion process and can also be rendered birefringent. These materials include polystyrene polymethylmethacrylate, polysulfone, poly(para-xylylene) and polyethylene-terephthalate.

(A0186) The Utsumi references discuss advantages of PEN over PET for specific uses – none of which, by the way, have anything to do with the dual properties of coextrusion and birefringence. In addition to Utsumi, one undoubtedly could find other references, discussing other uses, where PEN is likewise said to be better than PET or other polymers.³ On the other hand, one undoubtedly could find other references, discussing other uses, where PET is said to be better than PEN or other polymers.

³ One may wonder why, out of the universe of prior art discussing polymers and their properties, the Board focused on the Utsumi patents. The only conceivable reason is that they, like Rogers, discuss optical films in the broadest sense. But that similarity alone is not sufficient to motivate one skilled in the art to combine their teachings with Rogers, as discussed *infra* at pp. 6-7.

The same is true for the other polymers Rogers lists. One undoubtedly could find references, discussing other uses of polymers, where some other polymers are preferred over each of the polymers Rogers lists. Certainly there exists, for example, prior art discussing the advantages of using some other polymer in place of polystyrene, or in place of polymethylmethacrylate, and so on. If such a reference, no matter the use it discusses, is all that is required to constitute an “express suggestion” to substitute that other polymer in Rogers’ multilayer film in place of the particular polymer Rogers lists, one quickly reaches the point where the substitution of *any* new polymer in Rogers’ film is expressly suggested in the prior art.

Taken to its logical conclusion, then, the Director’s new, minimal standard for an “express suggestion” to combine references would lead to such absurd results. That is the problem with divorcing the question of what constitutes an express suggestion to combine references from the context of the references themselves, and from the nature of the problem to be solved. Without that frame of reference, one has no way of knowing – other than by pure hindsight – whether or not the inventors would have been motivated to substitute one material for the other in the context of their invention. And that is why this Court has not defined an “express suggestion” as broadly as the Board and Director seek here. The Court should decline the invitation to do so in this case.

II. The Director's Attempts to Bolster the Board's Finding of an "Express Suggestion" To Replace PET With PEN Fail.

Faced with the task of defending the Board's conclusory citation to alleged "express suggestions in both Utsumi references" regarding certain advantages of PEN over PET (A0006-7), the Director advances a number of arguments why those so-called "express suggestions" provide substantial evidence of a motivation to combine. But the Director's arguments fail because they again ignore the fundamental differences between the cited references, and the nature of the problem facing Drs. Wheatley and Schrenk. Equally flawed is the Director's decision simply to ignore Wheatley's evidence and arguments showing why a skilled artisan would *not* be motivated to make the Rogers-Utsumi combination.

A. The Director's "All Optical Films Are Alike" and "PEN Is a Better Polarizer Than PET" Arguments Make No Sense In the Context of the Cited Rogers-Utsumi Combination.

As explained in Wheatley's opening brief, the Board found the "express suggestions" to replace PET with PEN in Rogers in the Utsumi references' stated advantages of PEN over PET: "skilled artisans would have been motivated to use PEN in the multilayer film of Rogers to replace the PET to improve heat resistance, heat shrinkage ratio, mechanical properties, and the degree of polarization." (A0006-7) Implicitly recognizing that the first three of these advantages have nothing whatsoever to do with Rogers, the Director focuses on the

last one, characterizing the “key teaching” of the two Utsumi patents as follows:

“[t]hat PEN outperforms PET as a light-polarizing polymer.” (Dir. Br., p. 19)

That argument generalizes the teachings of the references to the point of meaninglessness. It is no better than saying that because Rogers and Utsumi both deal with optical films, their teachings are interchangeable. The mere fact that both Utsumi and Rogers deal with optical films in the most general sense does not constitute substantial evidence that the teachings of Utsumi would motivate one skilled in the art to modify the wholly different types of optical films disclosed in Rogers in the slightest.

The flaw in the Director’s logic is demonstrated by the very next sentence of the Director’s brief following the characterization of Utsumi’s “key teaching”:

Because of its inherent chemical properties, PEN will polarize light better than PET whether used as a single layer on a transparent substrate or used in alternating layers in a multilayer film.

(Dir. Br., p. 19)

First of all, the Director provides no record cite for this oversimplification because there is no support for it in the record. Neither the Examiner, nor the Board, nor the references themselves support this sweeping generalization.

Moreover, even if this “PEN is a better polarizer for all films” statement were an accurate synopsis of the teachings of Utsumi, it would only further highlight why one skilled in the art would not see those teachings as motivation to

replace the PET layer of Rogers with PEN. As the Director acknowledges (Dir. Br., pp. 4-5), Rogers does not teach that his alternating layers 10 and 12 (either of which may be made of PET) should be made of a polymer that is the best polarizer. That may be an advantage of Utsumi's single layer, single-polymer films, but not of Rogers' multilayer, multi-polymer films. Rather, in Rogers the two different polymers used in alternating layers 10 and 12 "should be selected to have as great a difference between the two indices of refraction as possible since the number of layers in the polarizer can be substantially decreased when using birefringent materials having a greater difference between their indices of refraction." (A185, col. 2, lines 60-65)

In other words, whether or not PEN is a better polarizer than PET in the abstract is irrelevant in Rogers' multilayer films. What is important is the refractive index mismatch between whatever polymer is used in one layer, and the polymer used in the alternating layer. The Director's "PEN is a better polarizer" argument thus provides no motivation for one skilled in the art to substitute PEN for PET in Rogers.

B. The Director First Concedes That the Problems Facing Drs. Wheatley and Schrenk Define What Art They Would Have Been Motivated To Combine, and Then Promptly Ignores Those Problems.

Wheatley's opening brief discussed at length a key problem facing the inventors: the need for an improved multilayer birefringent interference polarizer

that could be fabricated using established coextrusion techniques. In view of this problem, there was no motivation whatsoever to look to the teachings of the Utsumi references, which deal solely with monolayer films and hence say not one word about coextrusion of multilayer films.

In response, the Director argues that “[t]he problem allegedly solved by claim 30 does not negate the strong evidence of motivation in this case.” (Dir. Br., p. 23) The Director thus implicitly acknowledges the relevancy of the problem facing the inventors to the issue of motivation to combine art, but argues that here the problem solved is commensurate with the Rogers-Utsumi combination. (Dir. Br., p. 24: “both Rogers and the Utsumi patents address the general problem of polarization when using polymers”)

The Director’s argument lacks merit in two respects. *First*, it is simply a rehash of the flawed “PEN is a better polarizer for all films” argument discussed above. (See Dir. Br., p. 24: “the Utsumi patents teach that PEN polarizes light to a higher degree than PET”) Again, that argument generalizes the teachings of the references to the point of meaninglessness. Whether or not PEN is a better polarizer than PET in the abstract is irrelevant in the context of Rogers’ multilayer films, and there is no substantial evidence that the degree of polarization of PEN as compared to PET would motivate one skilled in the art to use PEN in place of a PET layer in Rogers.

The Director's citation to cases standing for the proposition that the prior art need not address the precise problem facing the inventors is misplaced for similar reasons. This is not simply a case where the art teaches the general problem facing the inventors, but not the specific solution; rather, the "PEN is a better polarizer" argument oversimplifies and generalizes the true problem facing the inventors to the point where it bears little, if any resemblance to their invention. Drs. Wheatley and Schrenk were not looking for a polymer with the best polarization. If they had been, they probably would have chosen a better polarizing material than PEN. Instead, they were trying to find an improved material for use as a layer of a multi-layer birefringent interference polarizer, and preferably one that could be fabricated using established coextrusion techniques. There is no suggestion anywhere in the art that PEN is the solution to that general problem.

Second, the Director's single-minded focus on the "PEN is a better polarizer" argument overlooks this Court's directive that "[i]n reviewing the record for substantial evidence, we must take into account evidence that both justifies and detracts from the factual determinations." *In re Kotzab*, 217 F.3d at 1369; *see also In re Zurko*, 258 F.3d 1379, 1384 (Fed. Cir. 2001). The Director simply ignores Wheatley's evidence that one skilled in the art seeking to make a multilayer film by coextrusion would not be motivated to substitute PEN based on the teachings of the Utsumi patents. The Director simply ignores Wheatley's evidence that Rogers'

teaching that “[c]ertain materials readily lend themselves to the coextrusion process” – including PET – suggests that other materials do not readily lend themselves to the coextrusion process, and thus implicitly teaches away from the Board’s Rogers-Utsumi combination. (A0154; A0186) Although the Director ignored this evidence, this Court should not, and this evidence confirms the conclusion that the Board’s finding of an express suggestion in the Utsumi patents to substitute PEN for PET in Rogers is not supported by substantial evidence.

III. The Director’s Waiver Argument Cannot Excuse the Board’s Failure To Cite Any Evidence Supporting a Finding That There Would Have Been a Reasonable Expectation of Success In Combining Rogers With Either Utsumi Reference

Regardless of whether there is a motivation to combine the prior art references forming the basis for an obviousness rejection, to support a proper *prima facie* obviousness determination, the Board must also cite substantial evidence establishing that one skilled in the art would have had a reasonable expectation of success in combining the references. *See In re O’Farrell*, 853 F.2d 894, 904 (Fed. Cir. 1988); *see also Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1164-65 (Fed. Cir. 2006). In other words, it is not enough for the Board to determine that it would have been “obvious to try” the combination of references. *In re O’Farrell*, 853 F.2d at 903-04.

Here, despite its knowledge of this longstanding requirement, the Board not only failed to cite substantial evidence, it failed to cite *any* evidence whatsoever

that one skilled in the art would have had a reasonable expectation of success in combining Rogers with one of the Utsumi references. In his opening brief, Wheatley pointed out that this omission constitutes a second, independent ground mandating reversal of the Board's decision.

In response, the Director does not attempt to defend the Board's indefensible omission. Rather, in a classic example of form over substance, the Director argues that Wheatley waived the argument by not making it to the Board. (Dir. Br., p. 25)

The Director's argument that Wheatley failed to use the magic words "reasonable expectation of success" in the brief to the Board ignores the fact that in substance, Wheatley argued exactly that. Specifically, Wheatley argued that the Utsumi references provide "*no guidance*" as to whether PEN would be an appropriate material to use in the multilayer film construction of Rogers, and thus at best it might have been "*obvious to try*" PEN:

The Utsumi references provide no guidance about whether PEN would or would not readily lend itself to such process [the coextrusion taught in Rogers]. At best, it might be argued that it would have been *obvious to try* PEN in the construction of Rogers in view of the Utsumi references, but such a standard of course falls short of that required to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). See In re O'Farrell, 853 F.2d 894, 7 USPQ2d 1673 (Fed. Cir. 1988); In re Fine, 837 F.2d 1071, ___ USPQ2d ___ (Fed. Cir. 1988).

(A0154) (emphases in original)

Wheatley's argument that at best it might have been "*obvious to try*" PEN in view of the Utsumi teachings is simply an alternative way of expressing the point that a motivation to combine references is not enough; one skilled in the art also must have a reasonable expectation that the combination he is motivated to make would be successful. As this Court has explained, that is the very reason why "obvious to try" is not the proper test for nonobviousness – it ignores the requirement of a reasonable expectation of success. *See, e.g., Velandier v. Garner*, 348 F.3d 1359, 1379 (Fed. Cir. 2003) ("Obviousness requires one of ordinary skill in the art have a reasonable expectation of success as to the invention – 'obvious to try' and 'absolute predictability' are incorrect standards.") (citing *In re O'Farrell*, 853 F.2d at 903); *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1207-08 (Fed. Cir. 1991) ("While [the district court] found that defendants had shown that these procedures were 'obvious to try,' the references did not show that there was a reasonable expectation of success.") (citing *In re O'Farrell*, 853 F.2d at 903-04).⁴

⁴ Moreover, Wheatley's argument that the Utsumi references provide "*no guidance*" as to whether PEN would be an appropriate material to use in the multilayer film construction of Rogers is another way of saying that the "reasonable expectation of success" requirement is not satisfied. *See Medichem*, 437 F.3d at 1165 ("[T]o have a reasonable expectation of success, one must be motivated to do more than merely to 'vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result'" (citing *In re O'Farrell*, 853 F.2d at 903); *In re Roemer*, 258 F.3d 1303, 1309-10 (Fed. Cir. 2001) (prior art that gives only general guidance merely meets "obvious to try" standard and does not support *prima facie* case of obviousness) (citing *In re O'Farrell*, 853 F.2d at 903).

Indeed, in the brief to the Board, Wheatley specifically cited *In re O'Farrell* to support the argument that the Utsumi references provide “no guidance” as to whether PEN would be an appropriate material to use in the multilayer film construction of Roger, and thus at best it would have been “obvious to try” PEN. (A0154) As the *Velandier*, *Amgen*, *Roemer* and *Medichem* cases cited above each illustrate, *In re O'Farrell* is *the case* commonly cited for the proposition that obviousness requires evidence establishing that one skilled in the art would have had a reasonable expectation of success in combining the cited references. The Board, with its vast experience in the evidence required to support a proper *prima facie* obviousness determination, certainly should have been expected to mention the evidence required by *In re O'Farrell* once Wheatley cited the case – *i.e.*, substantial evidence demonstrating a reasonable expectation of success.⁵

In the end, whether the exact words used are that the Rogers-Utsumi combination was merely “obvious to try,” or whether one says that the Rogers-Utsumi combination lacked a “reasonable expectation of success,” the point

⁵ The two cases the Director cites in support of the waiver argument are each distinguishable on the same grounds. Neither case involved a mere difference in semantics between the arguments to the Board and to this Court akin to what the Director bases the cry of “waiver” on here. Rather, in each of those cases, the applicant sought to raise a new substantive interpretation of the prior art for the first time on appeal. See *In re Watts*, 354 F.3d 1362, 1367-68 (Fed. Cir. 2004); *In re Hyatt*, 211 F.3d 1367, 1373 (Fed. Cir. 2000). Moreover, in neither of those cases had the applicant cited to the Board the controlling case from this Court that set forth the very legal rule the Board was alleged to have ignored, as is the case here with Wheatley’s citation of *In re O'Farrell* in a brief to the Board.


remains the same. On appeal to the Board, Wheatley argued that in view of the fundamental differences between the Utsumi patents and Rogers, the Utsumi references provide "no guidance" about whether PEN would work in the claimed construction, and at most would have made it "obvious to try" PEN. (A0153-54) Yet the Board's decision is completely silent as to any evidence supporting a reasonable expectation of success in combining Rogers and either Utsumi reference. For this additional and independent reason, the Board failed to make out a *prima facie* case of obviousness.

CONCLUSION AND STATEMENT OF RELIEF SOUGHT

For all of the foregoing reasons and the reasons explained in their opening brief, Appellants respectfully request that the Court reverse the decision of the Board, hold that claims 30 and 32-35 of the Application are patentable over the prior art, and instruct the PTO to issue the Application as a United States Patent.

Dated: October 6, 2006

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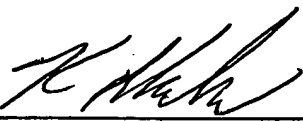
Pursuant to Fed. R. App. P. 25(d)(2), the undersigned counsel for Appellant hereby certifies that the foregoing Reply Brief of Appellants was filed on October 6, 2006 in accordance with Fed. R. App. P. 25(a)(2)(B) by mailing, via Express Mail, postage prepaid, twelve true and correct copies, including the original, to the Clerk of the United States Court of Appeals for the Federal Circuit, at the following address:

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The undersigned counsel for Appellant hereby certifies that two true and correct copies of the foregoing Reply Brief of Appellants were served on Appellee on October 6, 2006 by mailing via Express Mail, postage prepaid, to the following address:

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